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10/718,651	11/24/2003	Wilhelm Pfander	3120-57	1169

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EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/718,651

Applicant(s)

PFANDER

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 11232003.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,675,501. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations in the claims of the instant application are present in the claims of the Patent.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 9 and 15 each contains language similar to the phrase "a flexible cover member surrounding said intermediate member to conform substantially to the shape of the upper surface thereof". It is not clear how the intermediate member can have raised cushioning elements located on the upper surface and then the cover conforms to the upper surface of the intermediate member. The cover would have to conform to the raised cushioning members that are on the upper surface of the intermediate member.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-4, 6-12, 15-18 and 20 rejected under 35 U.S.C.

103(a) as being unpatentable over Vermeulen 4,223,455 in view of Argyris 5,799,413 and Potter et al. 5,755,001 or Goodwin et al.

5,993,585. Vermeulen '455 discloses substantially all the limitations of the claims including the following: a combination of a base 30 with an intermediate member 20 located upon the base and a cover 22 located on top of the intermediate portion. The base having perforations 26, the intermediate portion having a plurality of raised cushioning portions 32 extending from a surface; the base being flat (see Figures); intermediate member formed of soft foam (see col. 5, lines 11-12); an upper secured to an outsole (see Figure 11). Vermeulen '455 further teaches that the height and distance between the raised cushioning members 32 can vary according to the desired height of the midsole and the desired cushioning, therefore the cushioning members of Vermeulen '455 can be spaced apart 10-30 millimeters and have a height of approximately 6 millimeters. Vermeulen '455 does not disclose the intermediate member having a plurality of raised cushioning elements on the upper surface and a perforated cover member surrounding the intermediate member, conforming substantially to the shape of the upper of the intermediate member and extending beneath the base.

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Argyris '413 teaches that an intermediate member can have rounded raised cushioning members (12 in Figure 2) located on the top surface thereof that allows for a perforated cover member 14 to cover the lugs and conform to the shape of the upper surface of the lugs. The conforming of the upper cover to the shape of the lugs performs a massage-like effect on the user's foot when walking to improve blood circulation in the user's feet. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place raised cushion members on the top surface of the intermediate member of Vermeulen '455 and to fasten a perforated cover, such as that shown in Argyris '413, on top of the raised members to allow for the user's foot to be massaged when walking to aid in the circulation of blood throughout the user's feet.

Potter et al. '001 and Goodwin et al. '585 are examples of known prior art that teach that the cover member of an insert can surround and enclose the insert to allow for the insert to be removed as a whole and replaced. Therefore, it would have been obvious to make the cover of Vermeulen '455 surround and enclose the other members of the insert to allow for the insert to be applied and removed as one cohesive unit, as taught by Potter et al. '001 or Goodwin et al. '585.

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With regard to the limitation that the raised cushioning members being self-adjusting to the foot of the wearer to surround it and prevent it from slipping, this appears to be an inherent property of any foam which would compress a certain distance with respect to the weight applied and therefore, any foam which would conform to the user's foot. With respect to the prevention of slipping, if the foam is slightly larger than the user's foot, the front, sides, and rear of the foam would not compress and therefore would inherently prevent the user's foot from slipping.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 9 above in view of Kramer 5,233,767. The references as applied to claim 9 above disclose all the limitations of the claims except for the base member comprising soft, compressible inserts in the front and rear. Kramer teaches that a base portion of a midsole can contain inserts 40, 41, which are soft and compressible, to absorb shock from impact of the user's foot with the ground and ventilate the shoe during normal walking. Therefore, it would have been obvious, in view of Kramer '767, to place inserts, such as those shown in Kramer '767, in the base of the

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references as applied to claim 9 above, to give better shock absorption and to aid in ventilating the shoe.

8. Claims 5, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 4, 12 and 15 above in view of Polegato 5,983,524. The references as applied to claims 4, 12 and 15 above disclose all the limitations of the claims except for the base member having perforations in the upper surface and an upstanding perimeter rim surrounding the insole. Polegato '524 teaches that the upper surface of a base member (outsole) can contain perforations through it to aid in ventilating the shoe and that the insole of the shoe can be placed within an upstanding rim of the sole to help hold it in place (see Figures 7-9 and 11-12). Therefore, it would have been obvious, in view of Polegato '524, to place an upstanding peripheral sidewall and perforations in the upper surface of the base of the shoe of the references as applied to claims 4, 12 and 15 above, as shown by Polegato '524, to aid in ventilating the shoe and helping hold the insert within the sole.

#### ***Conclusion***



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Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125

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Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Primary Examiner  
Art Unit 3728

ADS  
June 21, 2004